

REMARKS/ARGUMENTS

Claims 1-9 and 18-20 remain pending for further prosecution. Although none of the claims has been amended or cancelled, a Listing of the Claims has been included for the convenience of the Examiner.

Allowable Subject Matter

Claims 18-20 have been allowed. Claims 5, 7, and 8 have been deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejection of claims 1-3, 6, and 9 under 35 U.S.C. § 103

Claims 1-3, 6, and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,597,149 to Hodge (“Hodge”).

Claim 1

Regarding claim 1, the office action generally alleges that it is irrelevant that Hodge teaches away from the claimed invention and that the proposed modification would render Hodge unsatisfactory for its intended purpose. Thus, according to the office action, it does not matter that the optical components in Hodge are separate from the optical table to provide a solution for “inflexible” systems. Apparently, according to the office action, what matters is that it “has been held that forming in one piece an article which has formerly been formed in two pieces involves only routine skill in the art” and that Hodge appears to show two pieces that have been formed into one by the current invention. These allegations are contrary to established patent law and plain logic.

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), Manual of Patent Examining Procedure (“MPEP”), Eighth Edition, Incorporating Revision No. 5, § 2143.01 (V), p. 2100-129, right column (emphasis added). There is no option or ambiguity as to what the conclusion should be when a proposed modification would render the prior art invention unsatisfactory for its intended purpose – the modification is improper.

In the present application, the office action acknowledges that the proposed combination would be rendered unsatisfactory for its intended purpose. In fact, the “flexible” system of Hodge is the exact opposite of the “inflexible” system claimed by claim 1. For example, while Hodge is directed to a flexible system that permits the mounting of a single item to a table in a plurality of configurations, the invention of claim 1 is directed to an inflexible system in which pre-located supports are arranged in a specific configuration to enable replication of an experiment. Clearly, the only conclusion in this case – based on legal precedent – must be that Hodge fails to suggest or motivate a skilled artisan to make the proposed modification. *Howard v. Detroit Stove Works* is not applicable at least because in that case the proposed modification did not render the prior art invention unsatisfactory for its intended purpose (*i.e.*, there was no teaching away). 150 U.S. 164 (1893).

Furthermore, it is simply illogical to rely for support on a reference when the reference itself contradicts the allegation. For example, it is illogical for John to conclude that Jane would approve of white flowers when Jane states that her favorite color is black. Similarly, it would be illogical for a skilled artisan to conclude that Hodge provides a motivation for an “inflexible” system when Hodge clearly teaches a “flexible” system. Hodge is very clear that a “drawback of the mounting system [of the prior art] is that it is relatively inflexible once it is placed on the bench.” Hodge, col. 1, ll. 60-61. Because Hodge deems systems that are inflexible as being problematic, it fails to support a modification directed to a flexible system.

Accordingly, the Applicants respectfully submit that claim 1, along with all the claims dependent therefrom, is patentable over Hodge at least for the applicable reasons stated above and for any other reasons previously presented. For example, claim 1 is patentable at least because Hodge teaches away from the claimed invention and the proposed modification would render Hodge unsatisfactory for its intended purpose, because the proposed modification would change the principle of operation of Hodge, and because the claimed invention provides numerous advantages over the mounting system of Hodge.

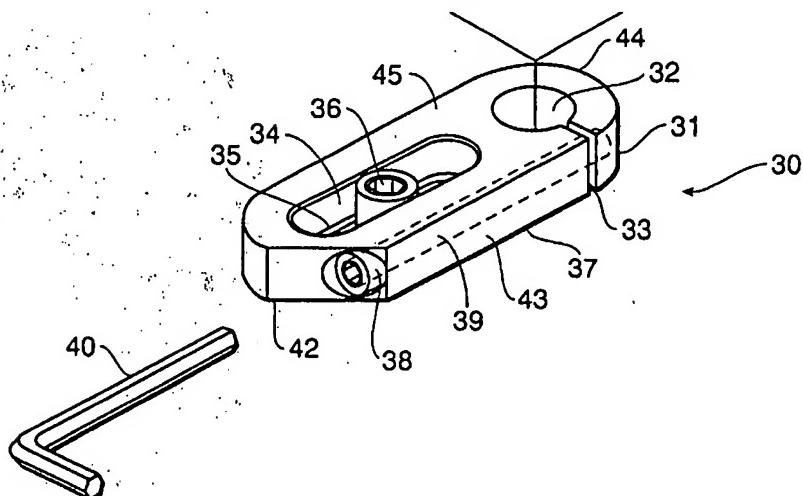
Claim 2

Regarding claim 2, the office action alleges that “posts with larger width are capable of fitting in the clamping base.” Specifically, the office action refers to FIG. 2 of Hodge, which

shows a bored hole 32 that may be adjusted by rotating a clamping screw 50 to grip a post by squeezing around the exterior of the post.

Claim 2 is directed to optical component supports that are provided in a “plurality of widths, and in a plurality of areas throughout said top surface of said base.” Clearly, the claim language requires at least two optical component supports simultaneously present on the top surface of the base, each of the optical component supports having a width that is different than the other optical component support. Hodge fails to teach or suggest these claim elements.

First, referring to FIG. 2 (reproduced in part below), the change in diameter of the bored hole 32 is not intended to accommodate posts 46 of different widths. The change in diameter of the bored hole 32 is intended to grip a post 46 of a specific (single) width. A clamp slot 33 is shown having a single dimension, which must be interpreted as accommodating a post 46 of a specific width. There is no indication that the bored hole 32 can stretch or expand to accommodate a post 46 having a larger width than the post 46 of a specific width. Similarly, there is no indication that the bored hole 32 can accommodate a post 46 having a smaller width than the post 46 of a specific width. The gap in the clamp slot 33 appears to only allow a relatively small adjustment in the bored hole 32. In other words, the design of the bored hole 32 is such that only the post 46 of a specific width can be grasped by the rotation of the clamping screw 50. Thus, the bored hole 32 is designed for attaching a post 46 of a specific width to the clamping base 30.



Second, nowhere does Hodge teach or suggest having two posts 46 of different widths simultaneously attached to an optical bench. In fact, the office action does not address this aspect of the claim. The portions of Hodge that are cited for support by the office action (*i.e.*,

col. 1, lines 37-41; col. 1, lines 45-47; and col. 2, lines 46-51) do not mention anything about this aspect of the claim.

Accordingly, the Applicants respectfully submits that claim 2 is patentable over Hodge at least for the above stated applicable reasons and for any other reasons previously presented.

Claim 6

Regarding claim 6, the office action alleges that FIGs. 3 and 4 show posts 20 and 22 for holding optical components. Previously, the Applicants respectfully noted that Hodge fails to disclose “two of said optical component supports [being] sized and positioned to act in concert to hold a single optical component.”

The Applicants respectfully request that this rejection be reconsidered. FIGs. 3 and 4 of Hodge have been reproduced below for the convenience of the Examiner. Nowhere do the figures show the alleged “posts 20 and 22.”

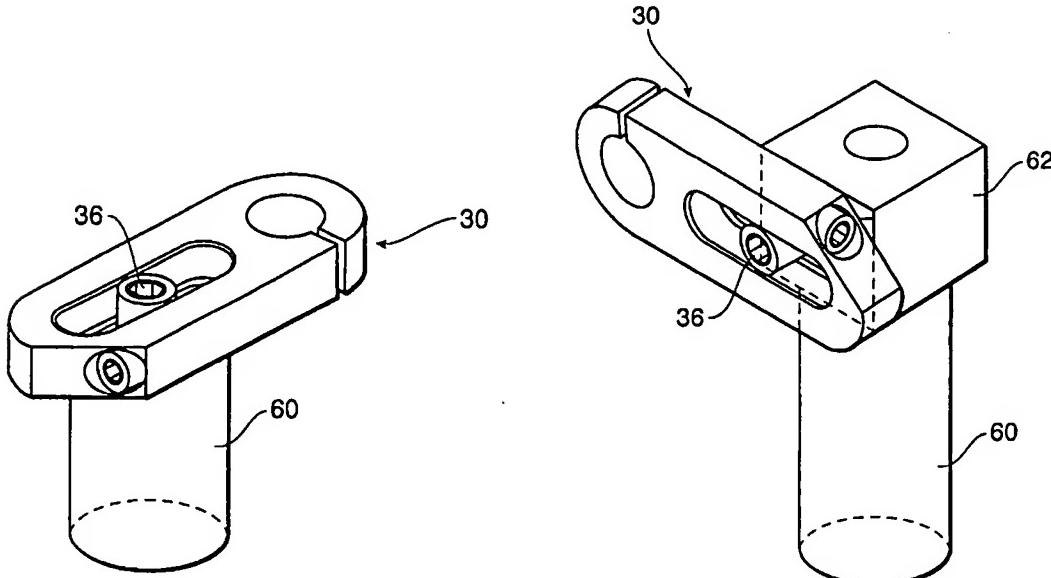


FIG. 3

FIG. 4

If, instead, the office action meant to refer to the “post 20” and the “post holder 22” that are shown in FIG. 1 (reproduced below), this fails to meet the claim element that require two supports.

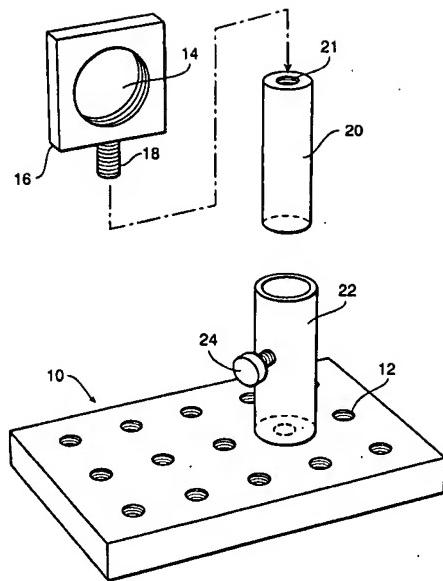


FIG. 1
Prior Art

In accordance with claim 1, from which claim 6 depends, the claimed supports are different supports that are integral with the base. In view of the claim language, the post 20 and the post holder 22 may arguably be interpreted (if at all) a single support.

Thus, the Applicants respectfully submit that the office action has failed to adequately support the rejection at least because the cited figures (FIGs. 3 and 4) do not show the alleges posts 20 and 22. At least for this reason, claim 6 should be allowable. In addition, even if it is assumed for arguments purposes that the office action should have cited FIG. 1, the post 20 and the post holder 22 do not meet the claim elements of claims 1 and 6.

The Applicants respectfully submit that claim 6 is patentable over Hodge at least for the above stated applicable reasons and for any other reasons previously presented. Alternatively, after consideration of the above arguments, claim 6 is still deemed unpatentable, the Applicants respectfully submit that the finality of the current office action should be removed because it is unfair for the Applicants to guess as to what the basis for rejection should be (*e.g.*, whether it should be FIGs. 3 and 4, whether it should be FIG. 1, or whether it should be other figures).

Rejection of claim 4 under 35 USC §103

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of U.S. Patent No. 6,771,437 B1 to Willis (“Willis”). Applicants respectfully submit that

claim 4 is patentable over Hodge in view of Willis at least for the applicable reasons stated above in reference to claim 1.

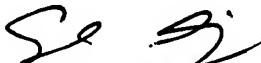
Conclusion

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP. Deposit Account No. 50-4181, Order No. 247080-000047USPT.

Respectfully submitted,

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